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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,300	09/30/2003	Gilad Odinak	018.0304.US.UTL	8164

22895 7590 06/15/2006

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EXAMINER

BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,300

Applicant(s)

ODINAK ET AL.

Examiner

Walter F. Briney III

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006 and 01 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 and 13-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "14a" has been used to designate both the upper and lower electrically contact of the ear plug in figure 1A.

Further, the drawing sheets filed 02 June 2006 do not include the legend "Replacement Sheet" in the top margin.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 1. Claims 1-11 and 13-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

Claims 1-11 and 13-21 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular, claim 1 recites “an electronic ear plug for providing a programmable audible alarm, comprising:... a memory provided separately within the audible alarm circuit... a leadless interface... and an alarm circuit” (emphasis added). Nowhere in the applicant’s specification can support for the “memory provided separately,” the “leadless interface” nor the “alarm circuit” be found.

At most, figures 4 and 5 respectively depict logical blocks 43 and 52, which represent a memory. The applicant interprets these logical depictions as support for the limitation “memory provided separately”, i.e. memory that is not integrated with some other feature of the clock circuit 41/51, for example, the timer 42. The passages recited on page 9 of the current response, filed 01 May 2006, fail to support the separate memory limitation. The passages clearly describe the function of the memory, and that it is included within the clock circuits 41/51, but set forth no insight into any physical parameter of the memory aside from the fact that the memory interfaces to leads 47/57/58.

In contrast to the applicant’s statement that the limitation of a “leadless interface” does not constitute new matter, figures 4 and 5 of the specification clearly illustrates leads running from ports 47/58 to the clock circuit 41/51. Figure 3 illustrates terminal 27, which interfaces with terminal 14 of the ear plug as illustrated in figure 1A. While it

might be maintained that these two terminals interface without interceding leads, leads bookend both terminals. The passages recited on page 9 of the current response, filed 01 May 2006, fail to support the leadless interface. In fact, none of the cited passages even mention a leadless interface, instead referring to the actual presence of wires/leads (page 6, lines 27-30).

The claim refers to both "a clock circuit" and "an alarm circuit." Figures 4 and 5 do not depict an "alarm circuit." It is noted that the clock circuit 41/51 must inherently retrieve "at least one programmable alarm tone from the memory to generate the at least one programmable alarm tone," but this function should further limit the claimed "clock circuit" rather than be defined as a discrete claim element.

Claims 8, 9 and 17 recite (8) "means for storing...provided separately," "leadless means for," "memory provided separately, (9) "a leadless interface," "an alarm circuit," "a leadless recharging interface," (17) "a memory provided separately" and "a leadless interface," which are all directed towards new matter for the same reasons provided above apropos the rejection of claim 1. In addition to the above list, the "means for saving" of claim 8 are not illustrated or disclosed.

Claims 2-7, 10, 11, 13-16 and 18-21 are rejected for the same reasons as their respective independent parent claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claims 1, 3-10 and 14-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (US Patent 6,906,983) in view of the extrinsic evidence Atmel 8-bit AVR® Microcontroller with 1K Byte Flash: Attiny11/Attiny12 specification (Rev. 1006D-AVR-07/03, Copyright 2003). Note the secondary reference is being applied in accordance with the rules set forth in MPEP § 2131.01(III).**

Claim 1 is limited to “an electronic ear plug for providing a programmable audible alarm.” It was shown apropos the rejection of claim 1 filed 30 January 2006 that Williams in view of the Atmel ATtiny12 specification anticipates an electronic ear plug comprising: an audible alarm circuit, an interface, a countdown timer and an ear plug. It has yet to be shown that the prior art anticipates “a memory provided separately,” “a leadless interface” rather than an interface and “a countdown timer” comprising “a clock circuit” and “an alarm circuit” for performing the functions of the timer already shown to be anticipated.

It is noted that the ATtiny12 processor 35 as shown in figure 3 of Williams includes an integrated memory 26 instead of “a memory provided separately.” However, this deficiency is overcome by an obvious modification.

In particular, if it can be shown that it would have been advantageous to be able to have a separately provided memory, it would have been obvious to do so. In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is “press fitted” and therefore not manually removable. The court held

that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose."). In this case, the integrated memory of the ATtiny12 processor corresponds to the "press fitted" cap of the prior art lipstick holder discussed in re Dulberg. It is well established that removable memories enable their subsequent replacement with memories that are more suited to any particular task. In essence, the memory of the ATtiny12 could be scaled as necessary for a particular application.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the integrated memory of the ATtiny12 processor with a replaceable memory for the purpose of enabling appropriate scaling for particular applications.

It is again noted that memory 26 of Williams corresponds to the 1K flash memory of the ATtiny12 processor. Only one memory exists, so all settings such as "user-settable time interval" and "at least one programmable alarm tone" must be stored therein. Further evidence of a programmed tone can be found in column 12, lines 1-3, of Williams.

The "leadless interface" of the claim reads on the stereo jack interface including elements 30 and 31 as seen in figure 3 of Williams. Clearly, no leads interface elements 30 and 31. The interface further includes PORTB of the ATtiny12 processor, which provide the ability to "store the user-settable time interval and at least one programmable alarm tone. The "countdown timer" of the claim comprises "a clock circuit," which reads on timer 25 of Williams, and "an alarm circuit," which reads on

controller 24 of Williams. See column 6, lines 6-14. Therefore, Williams in view of the ATtiny12 specification makes obvious all limitations of the claim.

Claims 3-7 are rejected for the same reasons presented above regarding claim 1 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

Claim 8 is limited to "an electronic ear apparatus for providing a programmable audible alarm." The "means for" recited in this claim have a one-to-one correspondence with the "memory provided separately," the "leadless interface," the "countdown timer," the "clock circuit," the "alarm circuit" and the "ear plug" of claim 1. Therefore, Williams in view of the ATtiny12 specification makes obvious all limitations of the claim.

Claim 9 is limited to "a programmable ear plug system providing an audible alarm." Is rejected for the same reasons presented above with respect to claim 1 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

Claims 10 and 14-16 are rejected for the same reasons presented above regarding claim 9 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

Claim 17 is limited to "a method for providing a programmable audible alarm through an electronic ear plug." It was shown apropos the Non-Final Office Action, filed 30 January 2006, that the "situating," "programming," and "placing steps" are anticipated by Williams in view of the ATtiny12 specification. However, the amended "placing step"

and the newly added "downloading" have yet to be shown as obvious in view of the prior art.

It is noted that the "placing step" has been amended to include "a clock circuit" and "a tone/alarm circuit," which have been shown apropos the rejection of claim 1 to be disclosed by Williams. It is further noted that the memory of Williams must store a tone for selection. See column 12, lines 1-3. This tone must inherently be downloaded into the memory. Further, it would have been obvious to provide the memory of Williams "separately" for the same reasons set forth in the rejection of claim 1.

Claims 18-21 are rejected for the same reasons presented above regarding claim 17 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

3. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of the Atmel Attiny12 specification and further in view of Aceti (US Patent 6,253,871).

Claim 2 is rejected for the same reasons presented above regarding claim 1 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

4. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of the Atmel Attiny12 specification and further in view of Knapp (US Patent 5,253,300).

Claim 11 is rejected for the same reasons presented above regarding claim 9 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

5. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of the Atmel Attiny12 specification and further in view of Mizoguchi et al. (US Patent 5,566,226).**

Claim 13 is rejected for the same reasons presented above regarding claim 9 as well as the respective reasons set forth in the Non-Final Office Action filed 30 January 2006.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WFB



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SUPERVISORY PATENT EXAMINER